

REMARKS

Claims 1-15 and 21-42 are pending in this application. Claims 1 and 12-15 are independent claims. Claims 1 and 12-15 are amended and claims 16-20 were previously cancelled.

Statement Under 37 C.F.R. § 1.133(b)

The Applicant thanks the Examiner for the courtesy shown during the telephonic interview conducted on March 31, 2009. During the interview, the rejections under 35 U.S.C. § 101 of claims 12, 13, and 21-30 were discussed. A proposed amendment to claim 12 to include the phrase "with a recording device" after the word "recording" on line 4 was discussed. The Examiner indicated that such an amendment would overcome the rejection of claim 12 and its dependent claims 21-25. A proposed amendment to claim 13 to add the phrase "with a reproducing device" after the term "reproducing" found on line 4 of claim 13 was discussed. The Examiner indicated that such an amendment would overcome the rejections under 35 U.S.C. § 101 of claim 13 and its dependent claims 26-30.

The rejections under 35 U.S.C. § 103(a) of the pending claims were also discussed. The Applicant's representative pointed out that Kato did not disclose a playitem that is a unit to be randomized or shuffled during random/shuffle reproduction as alleged in the Office Action of February 2, 2009. After reviewing the Kato reference, the Examiner agreed. The Applicant's representative also argued that the Examiner did not articulate which parts of Sato corresponded to the "playlist file" and the "segment launching a command indicating the playlist file." The Examiner indicated that Kato, rather than Sato, should have been cited to show the "playlist file"

but also agreed that Sato did not show a "segment launching a command indicating the playlist file" as recited in the claims. The Examiner indicated that in the next response, the Applicant should articulate the above arguments. Further, the Examiner stated that if the Examiner needs to rely on new art in a future Office Action to reject the claims in view of the arguments set forth above, that such an Office Action should not be made final as that new art should have been cited in the Office Action of February 2, 2009.

Rejections Under 35 U.S.C. § 101

Claims 12, 13, and 21-30 are rejected under 35 U.S.C. § 101 as allegedly not falling within one of the four statutory categories of invention. The Applicant does not agree that claims 12, 13, and 21-30 do not fall within one of the four statutory categories of invention. However, in an effort to forward prosecution, and in view of the comments made during the Examiner Interview mentioned above, claims 12 and 13 are amended. Claims 12 and 13 are amended to add the language "with a recording device" and "with a reproducing device," respectively. These added phrases describe apparatus that may be used in conjunction with the methods recited in independent claims 12 and 13. In view of the above remarks, the Applicant respectfully requests that the rejections under 35 U.S.C. § 101 of independent claims 12 and 13 and their dependent claims 21-30 be removed.

Rejections Under 35 U.S.C. § 103

Claims 1-15 and 21-42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,734,788 to Nonomura et al. ("Nonomura") in view of

U.S. Patent 7,236,687 to Kato et al. ("Kato") in view of U.S. Patent 5,884,004 ("Sato").
The Applicant respectfully traverses this rejection.

According to the new Examination Guidelines for Determining Obviousness under 35 U.S.C. § 103 in view of the Supreme Court decision of *KSR International, Co. v. Teleflex, Inc.* it is stated that the proper analysis for a determination of obviousness is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious. An Office Action must explain why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. See 72 Fed. Reg. 57526, 57528-529 (Oct. 10, 2007).

The Applicant asserts that neither Nonomura, Kato nor Sato, either separately or in combination, teach or suggest all of the limitations set forth in the claims, nor has there been a clear articulation made of why the differences between the prior art and the claims would have been obvious to one of ordinary skill in the art. The combination of Nonomura, Kato, and Sato does not teach or suggest at least two of the limitations set forth in the claims.

For example, independent claim 1 recites a computer readable medium including, among other things, wherein "the playitem is a unit to be randomized or shuffled during random/shuffle reproduction." The Office Action on page 5 asserts that this feature is described at column 8, lines 23+ of Kato. The Applicant respectfully disagrees. A review of the cited portion of Kato shows that Kato merely discloses determining a reproducing start position according to a random access playback. Kato never discloses any descriptions related to a random/shuffle reproduction.

Nonomura is described by the Examiner on page 4 to not disclose the above quoted feature of claim 1. Sato also does not disclose the above quoted feature nor is it alleged to. Therefore, for at least these reasons, the cited references, either taken separately or in combination, do not teach, suggest, or otherwise render obvious the above quoted feature of claim 1.

Furthermore, claim 1 also recites "a management area storing at least one title management information file, including at least one segment, the segment including a command which launches the playlist file, the title management information file being separate from the playlist file." The Office Action on page 4 admits that Nonomura does not disclose the above quoted feature of claim 1. In an attempt to cure the insufficiencies of Nonomura, the Office Action on pages 5 and 6 cites Sato at column 22, lines 38-40, column 20, lines 29-67, column 25, lines 7-67 through column 26, lines 1-7.

During the interview mentioned above, the Applicant stated to the Examiner that it appeared from the Office Action that the Examiner was alleging the navigation pack of Sato corresponds to the title management file and the navigation pack manages a playlist file. However, the Examiner did not clearly indicate which elements of Sato the Examiner considered to correspond to the playlist file and a segment including a command launching the playlist file. The Applicant requested clarification on these issues in order to respond to the Examiner's assertions.

The Examiner stated that Kato, rather than Sato, should have been cited to show the "playlist file." The Examiner also agreed that Sato did not show a segment launching a command indicating the playlist file. No other references were cited to cure the insufficiencies of Sato, Kato, and Nonomura.

For at least these reasons, the Applicant respectfully asserts that Nonomura, Kato and Sato, either separately or in combination, do not teach or suggest “a management area storing at least one title management information file, including at least one segment, the segment including a command which launches the playlist file, the title management information file being separate from the playlist file,” as recited in claim 1. For at least these reasons, the Applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) of independent claim 1 and its dependent claims 2-11 be removed.

The Applicant respectfully asserts that the other independent claims, claims 12, 13, 14, and 15, and their respective dependent claims, also recite language similar to that quoted above with respect to independent claim 1 and that the cited references Nonumura, Kato, and Sato do not teach or suggest all of the limitations set forth in those claims for at least the same reasons set forth above with respect to independent claim 1. For at least these reasons, the Applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) of claims 1-15 and 21-42 be removed.

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CONCLUSION

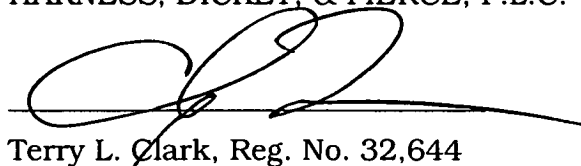
In view of the above remarks and amendments, Applicants respectfully submit that each of the rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,
HARNESS, DICKEY, & PIERCE, P.L.C.

By



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